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10/718,610	11/24/2003	Jan Alfons Bouwen	Q78296	1688

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EXAMINER
PASIA, REDENTOR M

ART UNIT	PAPER NUMBER
2416	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/718,610	BOUWEN, JAN ALFONS ALBERT
Office Action Summary	Examiner	Art Unit	
	REDENTOR M. PASIA	2416	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _16 September 2008_.
2a)☐ This action is FINAL. 2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under _Ex parte Quayle_, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-9 and 11_ is/are pending in the application.
  4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _1-9, 11_ is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on _24 November 2003_ is/are: a)☐ accepted or b)☒ objected to by the Examiner.
  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  a)☐ All b)☐ Some * c)☐ None of:
    1.☐ Certified copies of the priority documents have been received.
    2.☐ Certified copies of the priority documents have been received in Application No. _____.
    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
       application from the International Bureau (PCT Rule 17.2(a)).
  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
  Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   Applicant's amendment filed on Sept. 16, 2008 has been entered. No claims were
amended, cancelled or added. Claims 1-9 and 11 are still pending, with claims 1, 7, 8, 9 and 11
being independent.

Drawings

2.   The drawings are objected to under 37 CFR 1.83(a). The drawings must show every
feature of the invention specified in the claims. Therefore, the "storage station <u>comprising</u> a first
terminal" as shown in claim 9 must be shown or the feature(s) canceled from the claim(s). No
new matter should be entered.

        Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to
the Office action to avoid abandonment of the application. Any amended replacement drawing
sheet should include all of the figures appearing on the immediate prior version of the sheet,
even if only one figure is being amended. The figure or figure number of an amended drawing
should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure
must be removed from the replacement sheet, and where necessary, the remaining figures must
be renumbered and appropriate changes made to the brief description of the several views of the
drawings for consistency. Additional replacement sheets may be necessary to show the
renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an
application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet"

pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The

objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

4.   Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the

enablement requirement. The claim(s) contains subject matter which was not described in the

specification in such a way as to enable one skilled in the art to which it pertains, or with which

it is most nearly connected, to make and/or use the invention.

        While the specification along with the figure is enabling for a system comprising of a

first terminal, second terminal and a storage station, it is **not enabling** for "a storage station

comprising a first terminal" as shown in claim 9.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

6.   Claims 1, 3-9, 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnston

(US 7,266,591; hereinafter Johnston).

         As to claim 1, Johnston shows a system (Figures 1-6, note system employed in the

figures) for exchanging voice-packets via an Internet Protocol (abstract; Figure 1 shows

transmission of packetized voice data in a VOIP environment), the system comprising

         a first terminal (Figure 1, user agent 103) for transmitting said voice- packets via a

network (Figure 1, IP network) to a second terminal (Figure 1, user agent 101) for receiving said

voice-packets, which voice-packets form part of a call (Figures 3-5; col. 4, lines 12-35; shows

that a PC establishes a voice call with another PC where packetized voice data is transmitted

from the PC (i.e. user agent 103) via the IP network 105 to another PC (i.e. user agent 101).),

         wherein said network comprises a storage-station (Figure 1, content server 107) for

storing information (col. 7, line 7, content (i.e. music); it is noted that since the media session

(call) is established in a VOIP environment, the content shown is also seen as digital

content/information) to be supplied during said call to said second terminal (Figure 4; col. 6, line

54 to col. 7, line 7; it is shown that the content server 107 can begin transmitting content (i.e.

music files) to user agent 101 when the music-on-hold feature is activated during a media

session(call) is in progress) in the form of at least one data-packet via the Internet Protocol

(Figures 1-2; it is noted that the above components (i.e. user agents, content servers) are

interconnected through IP using TCP/UDP thereby showing in this instance that the music files

transmitted by the content server are in the form of packets/frames) in response to at least one

trigger-packet originating from said first terminal via the Internet Protocol (Figure 1, 4-5; col. 6,

line 54 to col. 7, line 7; it is shown that the content server 107 delivers the music content

(claimed storage station) to user agent 101 (claimed second terminal) when user agent 103 (claimed first terminal) initiates a music call-on-hold procedure by sending a INVITE message (claimed trigger packet) to content server 107).

As to claim 3, Johnston shows said trigger-packet is sent from said first terminal (Figure 4, user agent 103) to said storage-station (Figure 4, content server 107; it is shown in Figure 4 that the INVITE message is sent from user agent 103 to content server 107).

As to claim 4, Johnston shows said information (col. 7, line 7; content from content server 107) comprises information-parts (col. 3, lines 49-62; it is noted that the content in the content server can be music files, audio files or advertisement messages.), said trigger-packet comprising an indication for selecting at least one information-part to be supplied during said call to said second terminal (col. 8, lines 1-9; the user agent 103 may select the type of content to play to the user agent 101 using, for example, a special SIP header extension, which could be of the form "Music-On-Hold: classical" or "Music-On-Hold: http://www.music.com/classical-hits.wav" where a URL is used to reference a specific music wave file. This header could be either passed on unchanged by the proxy server 109 in the 3 pcc INVITE, or the header could be translated into a SIP Request-URI.).

As to claim 5, Johnston shows wherein said trigger-packet is sent from said first terminal to said second terminal (Figure 4, 405, 407; col. 6, lines 62-64; in step 405, the user agent 103 transmits an INVITE sdp MS message to the proxy server 109, which forwards the messages to the user agent 101), said second terminal in response to said trigger-packet generating a further trigger-packet to be sent during said call to said storage-station via the Internet Protocol (Figure 4, steps 411 onwards; in step 411, the user agent 101 sends a 200 OK sdp A message to the

proxy server 109; the proxy server 109 relays this message to the user agent 103 and in step 415,

the user agent 103 forwards an ACK sdp A messages to the content sever 107).

As to claim 6, this claim is rejected using the same reasoning set forth in the rejection of

claim 4.

As to claim 7, Johnston shows a terminal (Figure 1, user agent 103) for use in a system

(Figures 1-6, note system employed in the figures) for exchanging voice-packets via an Internet

Protocol (abstract; Figure 1 shows transmission of packetized voice data in a VOIP environment)

and comprising

said terminal (Figure 1, user agent 103) for transmitting said voice-packets via a network

(Figure 1, IP network) to another terminal (Figure 1, user agent 101) for receiving said voice-

packets, said voice-packets forming part of a call (Figures 3-5; col. 4, lines 12-35; shows that a

PC establishes a voice call with another PC where packetized voice data is transmitted from the

PC (i.e. user agent 103) via the IP network 105 to another PC (i.e. user agent 101).),

wherein said network comprises a storage-station (Figure 1, content server 107) for

storing information (col. 7, line 7, content (i.e. music); it is noted that since the media session

(call) is established in a VOIP environment, the content shown is also seen as digital

content/information) to be supplied during said call to other terminal (Figure 4; col. 6, line 54 to

col. 7, line 7; it is shown that the content server 107 can begin transmitting content (i.e. music

files) to user agent 101 when the music-on-hold feature is activated during a media session(call)

is in progress) in the form of at least one data-packet via the Internet Protocol (Figures 1-2; it is

noted that the above components (i.e. user agents, content servers) are interconnected through IP

using TCP/UDP thereby showing in this instance that the music files transmitted by the content

server are in the form of packets/frames) in response to at least one trigger-packet originating

from said other terminal via the Internet Protocol (Figure 1, 4-5; col. 6, line 54 to col. 7, line 7; it

is shown that the content server 107 delivers the music content (claimed storage station) to user

agent 101 (claimed second terminal) when user agent 103 (claimed first terminal) initiates a

music call-on-hold procedure by sending a INVITE message (claimed trigger packet) to content

server 107).

As to claim 8, Johnston shows a terminal (Figure 1, user agent 101) for use in a system

(Figures 1-6, note system employed in the figures) for exchanging voice-packets via an Internet

Protocol (abstract; Figure 1 shows transmission of packetized voice data in a VOIP environment)

and comprising

another terminal (Figure 1, user agent 103) for transmitting said voice-packets via a

network (Figure 1, IP network) to said terminal (Figure 1, user agent 101) for receiving said

voice-packets, said voice-packets forming part of a call (Figures 3-5; col. 4, lines 12-35; shows

that a PC establishes a voice call with another PC where packetized voice data is transmitted

from the PC (i.e. user agent 103) via the IP network 105 to another PC (i.e. user agent 101).),

wherein said network comprises a storage-station (Figure 1, content server 107) for

storing information (col. 7, line 7, content (i.e. music); it is noted that since the media session

(call) is established in a VOIP environment, the content shown is also seen as digital

content/information) to be supplied during said call to said terminal (Figure 4; col. 6, line 54 to

col. 7, line 7; it is shown that the content server 107 can begin transmitting content (i.e. music

files) to user agent 101 when the music-on-hold feature is activated during a media session(call)

is in progress) in the form of at least one data-packet via the Internet Protocol (Figures 1-2; it is

noted that the above components (i.e. user agents, content servers) are interconnected through IP using TCP/UDP thereby showing in this instance that the music files transmitted by the content server are in the form of packets/frames) in response to at least one trigger-packet originating from said other terminal via the Internet Protocol (Figure 1, 4-5; col. 6, line 54 to col. 7, line 7; it is shown that the content server 107 delivers the music content (claimed storage station) to user agent 101 (claimed second terminal) when user agent 103 (claimed first terminal) initiates a music call-on-hold procedure by sending a INVITE message (claimed trigger packet) to content server 107).

As to claim 9, Johnston shows a storage station (Figure 1, content server 107) for use in a system (Figures 1-6, note system employed in the figures) for exchanging voice-packets via an Internet Protocol (abstract; Figure 1 shows transmission of packetized voice data in a VOIP environment), the storage station comprising

a first terminal (Figure 1, user agent 103) for transmitting said voice-packets via a network (Figure 1, IP network) to a second terminal (Figure 1, user agent 101) for receiving said voice-packets, which voice-packets form part of a call (Figures 3-5; col. 4, lines 12-35; shows that a PC establishes a voice call with another PC where packetized voice data is transmitted from the PC (i.e. user agent 103) via the IP network 105 to another PC (i.e. user agent 101).),

wherein said network comprises said storage-station (Figure 1, content server 107) for storing information (col. 7, line 7, content (i.e. music); it is noted that since the media session (call) is established in a VOIP environment, the content shown is also seen as digital content/information) to be supplied during said call to said second terminal (Figure 4; col. 6, line 54 to col. 7, line 7; it is shown that the content server 107 can begin transmitting content (i.e.

music files) to user agent 101 when the music-on-hold feature is activated during a media

session(call) is in progress) in the form of at least one data-packet via the Internet Protocol

(Figures 1-2; it is noted that the above components (i.e. user agents, content servers) are

interconnected through IP using TCP/UDP thereby showing in this instance that the music files

transmitted by the content server are in the form of packets/frames) in response to at least one

trigger-packet originating from said first terminal via the Internet Protocol (Figure 1, 4-5; col. 6,

line 54 to col. 7, line 7; it is shown that the content server 107 delivers the music content

(claimed storage station) to user agent 101 (claimed second terminal) when user agent 103

(claimed first terminal) initiates a music call-on-hold procedure by sending a INVITE message

(claimed trigger packet) to content server 107).

As to claim 11, Johnston shows a method (Figures 4-5) for use in a system (Figures 1-6,

note system employed in the figures) for exchanging voice-packets via an Internet Protocol

(abstract; Figure 1 shows transmission of packetized voice data in a VOIP environment), the

method comprising:

transmitting said voice-packets (Figures 3-5; col. 4, lines 12-35; shows that a PC

establishes a voice call with another PC where packetized voice data is transmitted from the PC

(i.e. user agent 103) via the IP network 105 to another PC (i.e. user agent 101).) via a network

(Figure 1, IP network) from a first terminal (Figure 1, user agent 103) to a second terminal

(Figure 1, user agent 101);

receiving said voice-packets at said second terminal, wherein said voice-packets form

part of a call (Figures 3-5; col. 4, lines 12-35; shows that a PC establishes a voice call with

another PC where packetized voice data is transmitted from the PC (i.e. user agent 103) via the

IP network 105 to another PC (i.e. user agent 101).);

storing information in a storage-station in said network (Figure 1, content server 107

contains stored music files; col. 7, line 7, content (i.e. music); it is noted that since the media

session (call) is established in a VOIP environment, the content shown is also seen as digital

content/information);

supplying said information during said call to said second terminal (Figure 4; col. 6, line

54 to col. 7, line 7; it is shown that the content server 107 can begin transmitting content (i.e.

music files) to user agent 101 when the music-on-hold feature is activated during a media

session(call) is in progress) in the form of at least one data-packet (Figures 1-2; it is noted that

the above components (i.e. user agents, content servers) are interconnected through IP using

TCP/UDP thereby showing in this instance that the music files transmitted by the content server

are in the form of packets/frames) via the Internet Protocol in response to at least one trigger-

packet originating from said first terminal via the Internet Protocol (Figure 1, 4-5; col. 6, line 54

to col. 7, line 7; it is shown that the content server 107 delivers the music content (claimed

storage station) to user agent 101 (claimed second terminal) when user agent 103 (claimed first

terminal) initiates a music call-on-hold procedure by sending a INVITE message (claimed trigger

packet) to content server 107).

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

8.   Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston (US

7,266,591; hereinafter Johnston) in view of McCormack et al. (US 2002/0136384; hereinafter

McCormack).

As to claim 2, Johnston shows said voice-packets comprise at least audio (col. 4, lines 31-

35, shows a voice call is comprised of packetized voice data).

Johnston also shows (col. 3, lines 49-62) that the content server is primarily used as a

music server. However, it can also be seen that the content server can also store advertisement

messages and since the system of Johnston allows communication of a PC to another PC (col. 4,

lines 11-35), the implementation of transmitting video signals between terminals is not far off.

Still, Johnston does not specifically show said data-packet comprise at least video.

However, the above-mentioned claim limitation is well established in the art as evidenced

by McCormack. McCormack also shows a method of providing media content to callers on hold

(Figures 1-8, abstract).

Specifically, Johnston shows data-packet comprise at least video (abstract; shows media

content being supplied can either be music or video).

In view of the above, having the system of Johnston, then given the well-established

teaching of McCormack, it would have been obvious to one of ordinary skill in the art at the time

of the invention to modify the system of Johnston as taught by McCormack, in order to provide

improved quality media content to callers on hold (Par. 0008).

Response to Arguments

9.   Applicant's arguments, see Applicant's Remarks, filed Sept. 16, 2008, with respect to the

rejection(s) of claim(s) 1-4, 7-9 and 11 under 35 USC § 102(e) as being anticipated by Kung, et

al. (US 2003/0133358), and claims 5-6 under 35 USC § 103(a) as being unpatentable over Kung

in view of Girard (US 2002/1076404) have been fully considered and are persuasive. Therefore,

the rejection has been withdrawn. However, upon further consideration, a new ground(s) of

rejection is made in view of:

- Claims 1, 3-9, 11 are rejected under 35 U.S.C. 102(e) as being anticipated by

    Johnston (US 7,266,591; hereinafter Johnston).

- Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston (US

    7,266,591; hereinafter Johnston) in view of McCormack et al. (US 2002/0136384;

    hereinafter McCormack).

Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure:

        US 6,683,938

Any inquiry concerning this communication or earlier communications from the examiner should be directed to REDENTOR M. PASIA whose telephone number is (571)272-9745. The examiner can normally be reached on M-F 7:30am to 4:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung Moe can be reached on (571)272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aung S. Moe/   /Redentor M Pasia/
Supervisory Patent Examiner, Art Unit 2416   Examiner, Art Unit 2416